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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/785,760
Filing Date: February 16, 2001
Appellant(s): ABHYANKER, RAJ

Philip S. Lyren
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 13, 2008 appealing from the Office action mailed October 18, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20010009005	Godin et al	07-2001
CANADA: CN takes equity stake in FreightWise	UTU Daily News Digest "FreightWise"	11-2000

5,826,244	Huberman	10-1998
6,202,051	Woolston	03-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-26 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godin et al (US 20010009005) ("Godin") in view of UTU Daily News Digest, "CANADA: CN

takes equity stake in FreightWise" (November 14, 2000) ("FreightWise") and further in view of Huberman (US 5826244) ("Huberman").

Re claim 4: Godin teaches a method for aligning transactional flows within an internet exchange portal, comprising: facilitating a first auction on the portal for a sale of a good between a buyer and a seller (sections 0022-0025); sending the buyer a shipping form to gather a set of shipping data about shipping the good after the buyer and the seller agree for the sale of the good (section 0034, Figs. 11 and 12); collecting the set of shipping data for a contract entered into between the buyer and seller resulting from the sale of the good (section 34).

Godin does not specifically disclose the auction elements of the second auction for shipping services which include soliciting bids for shipping services required by a contract, receiving a set of shipping bids or selecting a bid from the set of bids according to a predetermined set of bid evaluation criteria. FreightWise discloses these as soliciting bids for shipping services for goods required by a contract, receiving a set of shipping bids, and selecting a bid from the set of bids according to a predetermined set of bid evaluation criteria (Page 1).

It would have been obvious to one of ordinary skill in that art at the time of the invention to modify Godin with the shipping service auction of FreightWise because this would provide a mechanism to effectively match the needs of a seller/shipper and capacities of shipping companies. See FreightWise at (paragraphs 9-10).

The Examiner notes that Applicants' claimed invention comprises two auctions. First, an auction for goods is performed, as per Godin. Next, an auction is performed to obtain shipping services for the good obtained at the first auction, as disclosed by FreightWise. However, Huberman

teaches the concept of conducting first and second auctions on the same portal (Col.18, lines 51-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Godin and FreightWise to be performed in the same internet exchange portal, a concept taught by Huberman. One would have been motivated to do so in order to allow entities to act as customers in the first auction and suppliers in a second auction, thereby enhancing the efficiency of the system.

Examiner notes that the assignee to the Sharp reference (FreightWise Corp.) had numerous publications/articles with respect to the business model disclosed in the Sharp reference prior to the effective date of the Sharp reference

Re claim 5: FreightWise teaches business-to-business auction (page 1).

Re claim 7: FreightWise teaches the collecting step includes the step of collecting a bidding-period; and the receiving step further comprising the step of receiving a set of shipping bids within the bidding-period (page 1).

Re claim 8: Official Notice is taken that the grouping of contracts for transportation (loads) is old and well known the freight transport. For example, a shipper having a standard fifty-three foot trailer would transport loads to a common destination from multiple parties, rather than shipping a single small load which would use only part of the trailer capacity.

It would have been obvious to one of ordinary skill in that art at the time of the invention to modify Godin/ FreightWise to group such loads and auction grouped contracts to more efficiently and profitably match customers and shippers.

See the **Hunt** reference (US 5724524) for support (Col. 6, line 40 to Col. 10, line 3).

Re claim 9: FreightWise discloses a plurality of shippers (page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Godin to include the plurality of shippers of FreightWise because this would provide competition in the selection of shipping suppliers and produce a lower shipping cost for the auctioned good.

Re claim 10: Godin discloses a predetermined set of shipping data (Fig. 11 and related text).

Re claim 11: FreightWise discloses seller bid evaluation criteria (page 1).

Re claim 12: Godin discloses selection by a seller from among forwarded bids (section 0002).

Re claim 13: FreightWise discloses selecting the bid with the lowest shipping price (section 0111).

Re claim 14: Official Notice is taken that a default selection absent an exact match was old and well known at the time of the invention. For example, selection of a "closest match" selection was known. It would have been obvious to one of ordinary skill in that art at the time of the

invention to modify Godin/FreightWise to select a default shipper in the absence of a match to predetermined criteria because this would assure that although sub-optimal, the selection would at least assure that shipping was accomplished.

See the **Burton** (US 20020007321) reference (sections 0222-0223) for support of this taking of Official Notice with respect to default suppliers of services.

Re claim 15: See the discussion of Claim 4

Re claims 16-17 and 19-26: See the discussion of Claims 4-5 and 7-14, of which they are computer-usable medium variants and are rejected in a like manner.

Re claims 28 and 29: See the discussion of claim 4.

Re claims 30 and 31: Huberman teaches selecting bid according to a set of predetermined bid evaluation criteria, wherein winning bid is based on other criteria in addition to price (col. 17, lines 26-35). It would have been obvious to one of ordinary skill in the art to modify Godin/FreightWise to include these steps. One would have been motivated to do so in order to predefine what makes a winning bid, thereby obviating the need for the customer/seller to select the winning bid.

Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godin in view of FreightWise in view of Huberman and further in view of Woolston (US 6202051) (“Woolston”).

Re claim 6: Godin discloses the invention substantially as claimed, including a contract consummation event (section 0023). See the discussion of Claim 4. Godin does not specifically disclose an auction service fee. Woolston discloses an auction service fee (Col. 21, lines 55-57). It would have been obvious to one of ordinary skill in that art at the time of the invention to modify Godin to include the auction service fee of Woolston so as to compensate the entity providing auction services.

Re claim 18: See the discussion of claim 16 and claim 6.

(10) Response to Argument

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art to combine both

auctions as taught by Godin and FreightWise into the same internet exchange portal. Huberman teaches conducting first and second auctions on the same portal (col. 18, lines 51-67). Applicant argues that Huberman does not explicitly disclose that the first and second auctions are hosted at the same portal. Examiner respectfully disagrees. Huberman does not suggest that these auctions are hosted at different portal. A reasonable interpretation of the cited portion of Huberman suggests that the same portal hosts the auctions.

Furthermore, it is very well known in the art to have a single portal host multiple auctions. To further buttress this assertion, see **Bansal** et al (US 6976005) at col. 13, lines 13-30.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the claim recite "soliciting bids for shipping services *for shipping the goods as required by the contract*". This recitation is treated as intended use of the soliciting step. The examiner notes that the intended use (or field of use) of the claimed invention must results in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
/O.A./
/Olabode Akintola/
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March 17, 2008

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